e) REMARKS

The claims are 1 and 3-17 with claim 1 the sole independent claim. The subject matter of claim 2 has been added to claim 1 and claim 1 has also been amended to better define the intended invention. Claim 4 has been amended as to form only. Reconsideration of the claims is expressly requested.

A corrected drawings sheet has been provided for Fig. 2 in order to delete the reference characters included, but not mentioned, in the specification.

The Examiner requested a corrected Abstract. A substitute specification has been provided and the Abstract has been corrected as requested in the substitute specification. A separate sheet for the Abstract has been provided with the corrected version.

The Examiner objected to the specification disclosure owing to various informalities. Typographical errors have been corrected and trademarks have been capitalized wherever noted. In view of the scope of the corrections a substitute specification has been provided. No new matter has been added.

The Examiner objected to the specification as failing to provide antecedent basis for claim 16. Accordingly, the subject matter for claim 16 has been added to the substitute specification in paragraph [230]. This objection should now been withdrawn.

Claims 1-17 were rejected under Rule 112, second paragraph. The objection to claim 4 has been resolved by adding a period (.) to the end of the claim.

Claim 1 was deemed indefinite in that the phrases relating to weight of liberation "a" and "b" were deemed unclear. In order to resolve this issue new paragraphs

[0055a - 0055d] have been added based on the supporting disclosure in paragraphs [0055] and [0056]. No new matter has been added.

Claim 1 has now been amended in order to incorporate the subject matter of claim 2.

In addition, in claim 1, the rate of liberation "b" of the inorganic fine powder is defined as "0.80 to 1.90". This range is based on the supporting disclosure in Examples 1-7 of the specification. The Examiner's attention is directed to substitute specification page 82 and Table 3. The rate of liberation "b" in Examples 1-7 is disclosed to be from 0.80 (in Example 7) to 1.90 (in Example 2) with values therebetween (i.e., 0.9, 1.1 and 1.3) in Examples 1 and 3-6.

It should be understood that Example 8 is beyond the scope of amended claim 1, since the rate of liberation "b" is 4.20%. In Table 4-1 and 4-2, at higher temperature, high humidity conditions, image density and transfer efficiency were lowest for Example 8 vs. Examples 1-7. In Tables 5-1 to 5-3 at room temperature and normal humidity, image density and transfer efficiency was lowest for Example 8. In Tables 6-1 and 6-2, at low temperature and low humidity, image density was lowest for Example 8. In Table 4-1, fogging, chargeability and dot reproduction were least satisfactory for Example 8. In Table 5-1, fogging and dot reproducibility were less satisfactory for Example 8, in Table 6-1, fogging was worst and in Table 6-2, dot reproducibility was worst for Example 8.

Claims 1, 5 and 7-16 are rejected under 35 U.S.C. §102(b) as anticipated by 2001/0028988 A1 (Magome). Claims 2-4 and 16 are rejected under 35 U.S.C. §102(b) as

anticipated by, or in the alternative, under 35 U.S.C. §103(a) as obvious over Magome. Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Magome combined with U.S. Patent No. 5,370,957 (Nishikiori) and U.S. Patent No. 6,709,798 B2 (Tamaoki). The grounds of rejection set forth in Paragraphs 11-14 of the outstanding Official Action are respectfully traversed.

Prior to addressing the grounds of rejection Applicants wish to briefly review certain key features which result in the present invention.

The developer of instant claim 1 has specific values for the rate of liberation "a" of the conductive fine particle and the rate or liberation "b" of the inorganic fine particles. In the present application, to obtain these specific values of "a" and "b", the conditions of external addition of the conductive fine particle and of the inorganic fine particle to the toner particle are controlled by adopting a two-step treatment process. Initially, the inorganic fine particle is added to the toner. Next, the conductive fine particle is added thereto. See paragraph [0059]; paragraphs [00231 and 00232] and "External Addition Condition" column of Table 3 on page 81 of the substitute specification.

On the other hand, in Comparative Examples 1-3 of the present application, the conductive fine particle and the inorganic fine particle are simultaneously added to the toner particle. At such a condition of external addition, developers, each having a rate of liberation "a" of less than 40%, were obtained. These developers are out of the scope of the amended claim 1 of the present application. (See "External Addition Condition" column of Table 3 on page 81 of the substitute specification.) These results indicate that it is difficult to satisfy both the rate of liberation "a" of the conductive fine particle and the

rate of liberation "b" of the inorganic fine particle by externally adding the conductive fine particle and the inorganic fine particle in a single step at the same time.

Magome '988 discloses liberation percentages of conductive fine powder of Magnetic Toners 1 and 2 in Table 2 and liberation percentages of conductive fine powder of Magnetic Toners 25 and 27 in Table 3 (see page 46 of Magome). However, these values are less that the lower limit of the rate of liberation "a" of the conductive fine particle provided in amended claim 1.

Liberation percentage of conductive fine powder of Magnetic Toner 26 disclosed in Magome satisfies the rate of liberation "a" provided in amended claim 1. However, liberation percentage of silica of the Magnetic Toner 26 in Magome is higher than the upper limit of the rate of liberation "b" of the conductive fine particle provided in amended claim 1.

In Magome, the inorganic fine powder and conductive fine powder were added to the toner by mixing the fine powders simultaneously with the toner. See Magome paragraphs [0279] and [0409]. The magnetic toners were formed by mixing the toner particle with silica fine powder and conductive fine powder, simultaneously. Magnetic Toners 1, 2 and 25-27 were made by simultaneous mixing of conductive fine powder and inorganic fine powder.

Accordingly, amended claim 1 of the present application is not anticipated by Magome nor rendered obvious thereby.

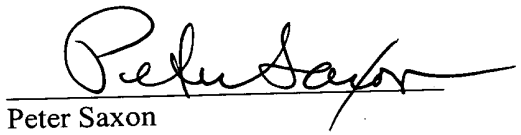
Further, neither Nishikiori nor Tamaoki disclose the developer of the present invention. Accordingly, claim 6 is not obvious from Magome combined with Nishikiori and Tamaoki.

Claims 1, 8, 9 and 13-16 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of U.S. Patent No. 6,596,452 (Magome). This rejection has been overcome because claim 1 has been amended to incorporate therein the subject matter of claim 2 which was not rejected over Magome.

Wherefore, it is submitted that none of the references, whether considered alone or in combination, disclose or suggest the present claimed invention nor render it unpatentable. Accordingly, it is requested that the claims be allowed and that the case be passed to issue.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



Peter Saxon
Attorney for Applicants
Registration No. 24,947

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

NY_MAIN 473659v1

ANNOTATED MARKED-UP DRAWINGS

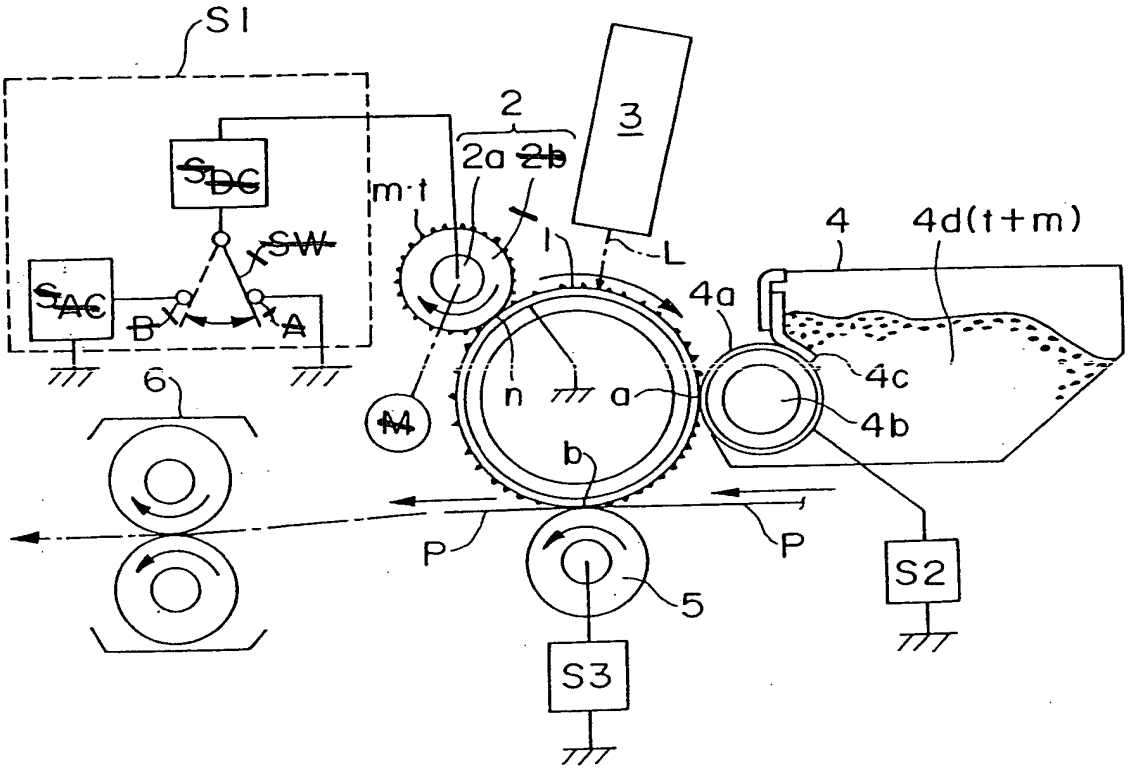


Fig. 2